

REMARKS

Claims 1-5, 7-8, 10-17, 19-32, 34-40, 42-49, 51-61, 63-69, 71-78, 80-87 and 89-100, are pending herein. Claims 6, 9, 18, 33, 41, 50, 62, 70, 79 and 88 have been cancelled without prejudice or disclaimer.

1. Claim 7-8, 19-20, 25-26, 28, 34-35, 39-40, 47, 52, 58, 63-65, 68-69, 76, 81 and 87 were rejected under 35 U.S.C §112, second paragraph.

It is noted herewith that majority of the claims have been amended. Accordingly, all of the pending claims are now believed to be in full compliance with §112. In particular, the trademark "Surfynol" has been replaced by a particular surfactant.

With respect to the rejections of Claims 7-8, 34-35 and 63-65, and 39-40 and 68-69, it is respectfully submitted that there is nothing inherently wrong with defining parts of an invention in functional terms, and functional language does not, in and of itself, render the claim improper. See MPEP §2173.05(g) and *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430(Fed. Cir. 1990) and *Schwing GMBH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 64 USPQ2d 1641, 1645 (Fed. Cir. 2002).

It is respectfully submitted that these claims further define the structure and/or function of the corresponding claimed elements. Therefore, it is respectfully submitted that Claims 7-8, 34-35, 39-40, 63-65, 68 and 69 are in full compliance with §112.

For the above-noted reasons, it is respectfully submitted that all pending Claims 1-5, 7-8, 10-17, 19-32, 34-40, 42-49, 51-61, 63-69, 71-78, 80-87 and 89-100 are in full compliance with §112. Therefore, it is respectfully requested that rejection of Claims 7-8, 19-20, 25-26, 28, 34-35, 39-40, 47, 52, 58, 63-65, 68-69, 76, 81 and 87 under 35 U.S.C. §112, second paragraph, be withdrawn.

2. Claims 1-8, 28, 88 and 98-100 were rejected under 35 U.S.C. §102(e) over Christensen (U.S. Patent Application Publication No. US 2003/0216815 A1). For the reasons discussed below, this rejection is respectfully traversed.

Independent Claims 1 and 98 have been amended and recite that the magnetically responsive fluid includes core particles of a magnetic material, wherein core particles include first and second successive coatings. As admitted by the Examiner in paragraph 6 of the Office Action, Christensen does not teach or suggest this claimed feature. Therefore, it is respectfully submitted that the subject matter of Claims 1-8, 28, 88 and 98-100 is neither anticipated by nor obvious over Christensen. Accordingly, it is respectfully requested that the rejection of these claims over Christensen be withdrawn.

3. Claims 1-2, 4, 6-8 and 88 were rejected under 35 U.S.C. §102(e) over Saiguchi (U.S. Patent Application Publication No. US2001/0011810*). For the reasons discussed below, this rejection is respectfully traversed.

*It is noted herewith that Saiguchi '810 reference was not listed on the Notice of References Cited, form PTO-892, attached to the Office Action of November 22, 2004. Accordingly, the Examiner is respectfully requested to forward another form PTO-892 listing this reference for the record.

Independent Claim 1 has been amended and recites that the magnetically responsive fluid includes core particles of a magnetic material, wherein core particles include first and second successive coatings. As admitted by the Examiner in paragraph 6 of the Office Action, Saiguchi does not teach or suggest this claimed feature. Therefore, it is respectfully submitted that the subject matter of Claims 1-2, 4, 6-8 and 88 is neither anticipated by nor obvious over Saiguchi. Accordingly, it is respectfully requested that the rejection of these claims over Saiguchi be withdrawn.

4. Claims 10-13, 26 and 95 were rejected under 35 U.S.C. §103(a) over Christensen '815 or Saiguchi '810. For the reasons discussed below, this rejection is respectfully traversed.

The Examiner admitted that neither Christensen '815 nor Saiguchi '810 shows the exact size of the magnetic particles. However, she stated that discovering the optimum or workable ranges involves only routine skill in the art and therefore, it would have been obvious to one having ordinary skill in the art to use particles with the claimed ranges. The Examiner further stated that neither Christensen '815 nor Saiguchi '810 discloses the exact fluid and/or material for the magnetic particles. However, she stated that it would have been obvious to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

It is respectfully submitted that general guidance with respect to a particular form of the claimed invention is tantamount to an “obvious to try” suggestion that is legally insufficient to support an obviousness rejection. *In re Roemer*, 258 F.3d 1303, 59 USPQ2d 1527 (Fed. Cir. 2001).

Accordingly, it is respectfully submitted that the rejection of Claims 10-13, 26, and 95 under 35 U.S.C. §103(a) over Christensen '815 or Saiguchi '810 is legally insufficient and should therefore be withdrawn.

5. Claims 6-26 and 95 were rejected under 35 U.S.C. §103(a) over Christensen '815 or Saiguchi '810 in view of Weiss et al. (U.S. Patent 5,599,474). For the reasons discusses below, this rejection is respectfully traversed.

The Examiner stated that either Christensen '815 or Saiguchi '810 shows a cushion substantially as claimed, except for the exact particles in the fluid. In support of her rejection, the Examiner cited Weiss to show the use of a particle with two coatings. The Examiner further stated that it is well known to use particles of differing diameters in a magnetorheological fluid.

It is respectfully submitted that Weiss et al. do not teach or suggest the use of particles that have two coatings. As noted in Column 9, lines 37-64, of Weiss et al., the particles may be encapsulated or covered by a surface barrier coating to prevent the growth of a contaminant layer. Weiss et al. therefore do not teach or suggest providing core particles with two successive coatings. Therefore, a combination, as suggested by the Examiner, would not result in the claimed

invention. Accordingly, it is respectfully submitted that the subject matter of Claims 6-26 is not obvious over Weiss et al.

With respect to the rejection of Claim 95, it is respectfully submitted that it is well-settled law that a conclusion of obviousness cannot be made from common knowledge or common sense. The PTO must point to some concrete evidence in the record to support its findings. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) and *In re Zurko*, 59 USPQ 2d 1693 (Fed. Cir. 2001).

In view of the above, it is respectfully submitted that Claims 6-26 and 95 are not obvious over Christensen '815, Saiguchi '810, and Weiss '474, alone or in any combination thereof. Therefore, it is respectfully requested that the rejection in this regard be withdrawn.

6. Claims 27, 29-40, 42-45, 59-69, 71-74, 89-94, 96 and 97 were rejected under 35 U.S.C. §103(a) over Demon (U.S. Patent 5,813,142) in view of either Christensen '815 or Saiguchi '810. For the reasons discussed below, this rejection is respectfully traversed.

As noted above, neither Christensen '815 nor Saiguchi '810 teaches or suggests the use of a magnetically responsive fluid which includes core particles of a magnetic material, wherein the core particles include first and second successive coatings. It is respectfully submitted Demon also lacks in teaching or suggesting the use of the claimed fluid. Thus, a combination, as suggested by the Examiner,

would not result in the claimed invention. Therefore, it is respectfully submitted that the subject matter of Claims 27, 29-40, 42-45, 59-69, 71-74, 89-94, 96 and 97 is not obvious over Christensen '815, Saiguchi '810, and Demon '142, alone or in any combination thereof. Accordingly, the rejection of these claims over these references is respectfully requested to be withdrawn.

7. Claims 41, 46-58, 70 and 75-87 were rejected under 35 U.S.C. §103(a) over Demon '142 in view of either Christensen '815 or Saiguchi '810, and further in view of Weiss '474. For the reasons discussed below, this rejection is respectfully traversed.

As admitted by the Examiner, Demon is deficient in teaching the claimed particles in the fluid. However, the Examiner stated that Weiss teaches the use of a particle with two coatings. As noted above, Weiss does not teach or suggest the use of particles with two coatings. Thus, a combination, as suggested by the Examiner, would not result in the claimed invention. Therefore, it is respectfully submitted that the subject matter of Claims 41, 46-58, 70 and 75-87 is not obvious over Demon '142, Christensen '815, Saiguchi '810, and Weiss '474, alone or in any combination thereof. Accordingly, it is respectfully requested that the rejection of these claims over these references be withdrawn.

PROPRIETARY INFORMATION DISCLOSURE STATEMENT

The Examiner is respectfully requested to acknowledge review of the material submitted via the Proprietary Information Disclosure Statement filed on February 25, 2004.

CONCLUSION

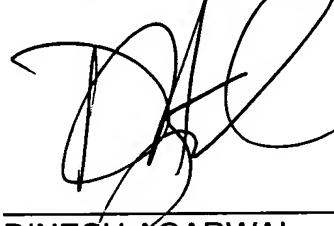
For the foregoing reasons, it is respectfully submitted that Claims 1-5, 7-8, 10-17, 19-32, 34-40, 42-49, 51-61, 63-69, 71-78, 80-88 and 89-100, are all in condition for allowance. Withdrawal of all of the rejections and allowance of these claims are respectfully solicited.

It is believed that no additional fee is due for this submission. However, should that determination be incorrect, the Commissioner is hereby authorized to charge any deficiencies, or credit any overpayment, to our Deposit Account No. 01-0433, and notify the undersigned in due course.

Appl. No.: 10/624,519
Amdt. dated May 20, 2005
Reply to Office Action of November 22, 2004

Should the Examiner have any questions or wish to discuss further this matter, please contact the undersigned at the telephone number provided below.

Respectfully submitted,



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